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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,489	04/20/2004	Tsu-Wang Chen	546.08	4853

7590 06/19/2006  
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EXAMINER	
BASEHOAR, ADAM L	
ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/828,489

Applicant(s)

CHEN ET AL

Examiner

Adam L. Basehoar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>05/25/04 04/24/06</u> . | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. This action is responsive to communications: The Application filed 04/20/04.
2. Claims 1-19 are pending in the case. Claims 1, 6, and 12, are independent claims.

### ***Information Disclosure Statement***

3. The information disclosure statements (IDS) submitted on 05/25/04 and 04/24/06 have been considered by the examiner.

### ***Claim Objections***

4. Claims 15, 18, and 19 are objected to because of the following informalities:  
Claims 15, 18, and 19, appear to have improper claim dependency. Claim 15 should depend from independent claim 12. Claim 18 should depend from dependent claim 17. Claim 19 should also depend from dependent claim 17. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bevin et al (US-2003/0210428 11/13/03) in view of Palmer (US-6,078,403 06/20/00).

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-In regard to substantially similar independent claims 1, 6, and 12, Bevlin teaches a computer implemented method and system for producing a printable document, comprising:

importing form and content data comprising a document into a print generation process (Paragraph 16: "print format language (PFL) file");

extracting graphical layout information (i.e. mapping of location of zones and location of words) and content data (i.e. field values, words, etc) from the document to produce a stripped document (Paragraphs 16-17: "A corresponding PFL....were extracted from"; Paragraph 36: "extracts data....database");

defining metadata specifying data types and data field coordinates from the graphical layout information and the content data (Paragraphs 17 & 36-37);

merging the stripped document with the metadata and content data by the new data system to produce a document consisting of the content data in a format consistent with the imported document from the legacy system (Paragraph 41: "The objective....data system"). Bevlin teaches wherein the form could contain dynamic portions that include variable content (i.e. content that may differ on different forms)(Paragraph 47). Bevlin does not specifically teach wherein new content data was merged with the stripped document with metadata to produce a new document. Palmer teaches merging new variable content (Fig. 2: 48: "variable data file") with a stripped base document (Fig. 2: "Base Document") to create a new merged document (Fig. 2: 52) to be printed (Fig. 2: 54). It would have been obvious to one of ordinary skill in the art at the time of the invention for the stored stripped document of Bevlin to have allowed new content to be merged into the noted dynamic zones of Bevlvin, because Palmer teaches

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that by inserting variable data into a base document a plurality of different output documents could be created.

-In regard to dependent claims 2, 7, and 13 Bevin teaches wherein the document comprises a form consisting of pre-defined fields, with each field of the pre-defined field containing a unique portion of content data (Paragraphs 16-17 & 36-37)(Fig. 4).

-In regard to dependent claims 3, 8, and 14, Belvin teaches wherein metadata comprises rules defining coordinate location and appearance information for each of the pre-defined fields (Paragraphs 16-17, 36-37, & 52-54).

-In regard to dependent claims 4, 9, and 15, Belvin teaches processing the content data in a script interpreter sub-process prior to merging the content data with the stripped document and metadata (Paragraph 58: "In optional embodiments....identified in the script").

-In regard to dependent claims 5, 10, and 16 Belvin teaches wherein the content data was stored in a memory storage coupled to a computer importing the form and content data (Fig. 3: PFL file, PFL template, New DB).

-In regard to dependent claim 11, Belvin teaches generating the pre-defined document as a PDF document (Paragraph 16: "Adobe PDF file"; Paragraph 44: "PDF");

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and defining the metadata within the PDF document (Paragraph 17: “stored in the PFL”; Paragraph 46; Paragraphs 52-54).

-In regard to dependent claim 17, Belvin teaches wherein the input process was executed on a server computer (i.e. legacy system)(Fig. 3: 100) coupled to a client computer (i.e. new data system)(Fig. 3: 102) over a network, and wherein the memory storage (Fig. 3: 104, 124: i.e. databases) was coupled to the network.

-In regard to dependent claim 19, Belvin teaches a wherein a PFL-compatible printer would produce the printed form (Paragraph 38: “A printed form....PFL file”; Paragraph 41: “The objective....database system”). Belvin does not specifically teach a printing device coupled to the network and configured to print the document. Palmer teaches a printer (Fig. 2: 12) coupled to the network configured to print the new document (Fig. 2: 54). It would have been obvious for the system of Belvin to have had a printer coupled to it as shown in Palmer, because both Palmer and Bevin teach the well known necessity of a printing device to print a hard copy of the documents.

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bevin et al (US-2003/0210428 11/13/03) in view of Palmer (US-6,078,403 06/20/00) in further view of Larsen et al (US-6,088,700 07/11/00).

-In regard to dependent claim 18, Belvin teaches wherein printable document was a PDF document (Paragraph 16: “Adobe PDF file”; Paragraph 44: “PDF”). Belvin does not specifically teach wherein the transfer network was the world wide web portion of the

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Internet. Larsen teaches a global information network for automated forms completion wherein the network included the world wide web portion of the Internet (Fig. 1: "PDF Forms over the WWW"). It would have been obvious to one of ordinary skill in the art at the time of the invention for the transfer network of Bevin to have comprised the world wide web of the Internet as shown in Larsen, because Larsen teaches what was notoriously well known at the time of the invention that the world wide web allowed increased data transfer access to a global connected community.

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

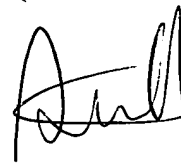
US-5995,985	11-1999	Cai, Yunming
US-6,851,087	02-2005	Sibert, Mark
US-6,662,340	12-2003	Rawat et al
US-5,704,029	01-2002	Alam et al.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam L. Basehoar whose telephone number is (571)-272-4121. The examiner can normally be reached on M-F: 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ALB

**STEPHEN HONG**  
**SUPERVISORY PATENT EXAMINER**